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In re Application of:
AOKI, TAKASHI et al
Application Serial No.: 10/526,490
Filed: March 04, 2005

For: **IMAGE PROCESSING APPARATUS AND
IMAGE PROCESSING METHOD**

:
: DECISION ON PETITION TO
: WITHDRAW RESTRICTION
: REQUIREMENT UNDER
: 37 CFR 1.144

This is a decision on the petition filed September 23 2008, under 37 CFR § 1.144 requesting withdrawal of the restriction requirement issued by the examiner on April 28, 2008; traversed by applicants in a response filed June 11, 2008; and maintained by the examiner in an Advisory action dated July 25, 2008.

BACKGROUND:

The application was filed on March 04, 2005 with claims 1-6 directed to an image processing apparatus for trimming out a part of image data stored in a memory and transferring the trimming image data (claims 1-4) and an image processing method for trimming out a part of image data stored in a memory and transferring the trimming image data (claims 5-6).

On October 03, 2007, a rejection of claims 1-6 in the application was mailed.

On January 10, 2008, an amendment was filed adding claims 7-14 directed to "an image processing apparatus for trimming an image portion from an original image stored in a memory and transferring the trimmed image portion" (claims 7-12) and an image processing method for trimming an image portion from an original image stored in a memory and transferring the trimmed image portion (claims 13-14).

On April 28, 2008, A Final Office action was mailed including (1) election of claim 1-6 by original presentation, (2) withdrawal of claims 7-14 from consideration as non-elected due to a different embodiment of the invention where they teaches a memory module and processor that issues a controller command to retrieve the trim image and the controller is configures to

command the corresponding data reader to read only the trimmed image in these claims and (3) maintaining the rejection of claims 1-6.

On June 11, 2008, Applicant filed an amendment after final that traversed the examiner's holding that claims 7-14 are directed to a different invention than claims 1-6. Also included was an amendment to the claims.

On July 25, 2008, an Advisory action was mailed that denied entry of the amendment and maintained the restriction requirement.

On September 23, 2008, applicant filed the instant petition arguing the examiner has failed to show the inventions to be independent or distinct and the examiner has failed to show why the invention recited in claims 7-14 would impose an undue burden.

REGULATIONS AND PRACTICE

37 C.F.R. § 1.143 states:

If the applicant disagrees with the requirement for restriction, he may request reconsideration and withdrawal or modification of the requirement, giving the reasons therefor. (See § 1.111). In requesting reconsideration the applicant must indicate a provisional election of one invention for prosecution, which invention shall be the one elected in the event the requirement becomes final. The requirement for restriction will be reconsidered on such a request. If the requirement is repeated and made final, the examiner will at the same time act on the claims to the invention elected.

37 C.F.R. § 1.144 states:

After a final requirement for restriction, the applicant, in addition to making any reply due on the remainder of the action, may petition the Commissioner to review the requirement ... A petition will not be considered if reconsideration of the requirement was not requested (see § 1.181).

37 C.F.R. § 1.145 states:

If, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered, subject to reconsideration and review as provided in §§ 1.143 and 1.144.

37 C.F.R. § 1.181 states:

- (a) Petition may be taken to the Commissioner:
 - (1) From any action or requirement of any examiner in the ex parte prosecution

of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;

(2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and

(3) To invoke the supervisory authority of the Commissioner in appropriate circumstances. For petitions in interferences, see § 1.644.

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the ex parte prosecution of an application, or in the ex parte or inter partes prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner. The examiner may be directed by the Commissioner to furnish a written statement, within a specified time, setting forth the reasons for his or her decision upon the matters averred in the petition, supplying a copy to the petitioner.

MPEP § 803 states:

Under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 806.04 - § 806.04(i)) or distinct (MPEP § 806.05 - § 806.05(i)).

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

CRITERIA FOR RESTRICTION BETWEEN PATENTABLY DISTINCT INVENTIONS

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(i)); and

(B) There would be a serious burden on the examiner if restriction is not required (see MPEP § 803.02, § 808 and § 808.02

MPEP § 821.01 states:

Where the initial requirement is traversed, it should be reconsidered. If, upon reconsideration, the examiner is still of the opinion that restriction is proper, it should be repeated and made final in the next Office action. (See MPEP § 803.01.) In doing so, the examiner should reply to the reasons or arguments advanced by applicant in the traverse. Form paragraph 8.25 should be used to make a restriction requirement final.

OPINION

37 C.F.R. § 1.181(c) requires that an action by an examiner, to be properly petitionable, must be followed by a request for reconsideration, and a repeated action by the examiner. 37 C.F.R. § 1.144 states that the applicant may petition the Commissioner after a final requirement for the restriction has been made.

In the above-identified application, applicant filed a request for reconsideration prior to the petition of September 23, 2008, in accordance with 37 C.F.R. § 1.143. Although the restriction was never made final in accordance with MPEP § 821.01, the initial restriction requirement was maintained in the advisory action. To expedite prosecution of this application, the Office action of July 25, 2008, which maintained the restriction requirement, is being treated as a Final restriction requirement.

The issue presented in the petition is whether the restriction based on original presentation under 37 C.F.R. § 1.145 is proper under the current regulations and practice.

MPEP § 803 sets forth two criteria for a proper restriction requirement between patentably distinct inventions: (A) The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(i)); and (B) There would be a serious burden on the examiner if restriction is not required (see MPEP § 803.02, § 808 and § 808.02).

The issue at hand is whether or not claims 1-6 are directed to a different invention than new claims 7-14. Upon further review, the office action of 4/28/08 states:

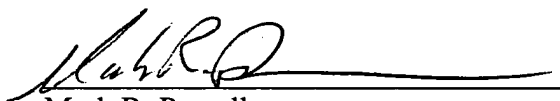
...claims 7-14 disclose different embodiment of the invention where they teach a memory module and a processor that issues a controller command to retrieve the trim image and the controller is configured to command the corresponding data reader to read only the trimmed image. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits.

A review of the record finds that the office action of 4/28/08 failed to set forth whether the inventions are independent in accordance with MPEP § 802.01, § 806.04, § 808.01 or distinct in accordance with MPEP § 806.05 - § 806.05(i). Also, the office action failed to set forth a serious burden on the examiner in accordance with MPEP § 803.02, § 808 and § 808.02.

CONCLUSION

For the above stated reasons, the petition to withdraw the restriction requirement is **GRANTED**.

The Final rejection mailed April 28, 2008 is hereby VACATED. The amendment filed 6/11/08 is entered. The Pre-appeal brief conference request filed 9/23/08 is dismissed. The Application is being returned to the examiner to set forth a restriction of claims 1-14 as filed on 6/11/08 in the format defined by MPEP 800 or an office action on the merits of claims 1-14 as filed on 6/11/08.

A handwritten signature in black ink, appearing to read 'Mark R. Powell', is written over a horizontal line.

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